

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*AS*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/196,916 11/20/98 RUMBACH

A 364/51

EXAMINER

IM62/0313

MOVEMENT ART UNIT, J PAPER NUMBER

9

KENYON & KENYON  
ONE BROADWAY  
NEW YORK NY 10004

1775  
DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/196,916	Applicant(s) Rumbach et al
Examiner Jennifer McNeil	Group Art Unit 1775

Responsive to communication(s) filed on Feb 23, 2001

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 3-8 and 11-17 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 3-8 and 11-17 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1775

## **DETAILED ACTION**

### ***Specification***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because applicant has failed to provide an adequate written description of the invention. The copper-nickel-zinc alloy is reported in percentages, however, it is never clarified whether this is atomic or weight percent.

The amendment filed 11/15/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the

Art Unit: 1775

original disclosure is as follows: notation of the composition of the alloy material in weight percent.

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-8, and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are amended to define the metal alloy facing in weight percent. As stated previously, the specification does not disclose whether the alloy is noted in weight or atomic percent. Therefore this addition to the claims is considered new matter.

Claims 3-8, and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The proper notation of the percentages, whether atomic or weight, of the alloy is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356

Art Unit: 1775

(CCPA 1976). The specification and claims fail to disclose whether the alloy is reported in atomic or weight percent. This omission renders the claims not enabled.

*Allowable Subject Matter*

Claims 3-8, and 11-17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or render obvious an electrically conductive metal strip for the production of electrical components comprising a core strip made of a copper material; and a metal facing made of a copper-nickel-zinc alloy, roll-bonded clad on at least one side of the substrate, said metal facing consisting of CuNi18Zn27 by weight percent. The prior art also does not teach or render obvious a metal facing of the above strip with a composition consisting of CuNi18Zn20, or CuNi12Zn24 by weight percent.

*Response to Arguments*

Applicant's arguments filed 11/15/00 have been fully considered but they are not persuasive. Applicant's arguments regarding the 112 first paragraph rejection have been noted. Applicant states that the matter of atomic vs. weight percent composition has been clarified with the amendments to the claims. Amendments to the claims and specification must find support in the application as originally filed. As stated previously, the specification does not reflect the notation of the composition of the alloy. It is the examiner's position that the amendment to the instant specification which denotes the intended notation is new matter. It has been established

Art Unit: 1775

that compositions directed to alloys used in electrical applications are not solely reported in weight percent and are reported using both notations.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer McNeil whose telephone number is (703) 305-0553. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at (703) 308-3822.

When filing a fax in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of this application. This will expedite processing of your papers. The fax number for this Group are (703) 305-3599 for "Official" faxes and (703) 3055436 for "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0661.

  
Jennifer McNeil  
Patent Examiner  
AU 1775

  
DEBORAH JONES  
EXAMINER